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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,356	02/08/2001	Michael Wayne Brown	AUS920000949US1	5780

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EXAMINER

MOONEYHAM, JANICE A

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 05/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/779,356

Applicant(s)

BROWN ET AL.

Examiner

Jan Mooneyham

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This is in response to the applicant's communication filed on February 8, 2001. Claims 1-36 are currently pending in this application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

What does the applicant mean by the term "affect of the proposed legislation?" How does the applicant calculate an affect of the proposed legislation based on the legislation data?

How is the calculating done?

How is the data obtained?

How are the e-mail addresses obtained ?

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-3 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1-4 only recite an abstract idea. The recited steps of merely obtaining data, calculating an affect and outputting the affect does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea. There is not technology in the body of the claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1,2,13,14, 25, and 26 rejected under 35 U.S.C. 103(a) as being unpatentable over Schultz (US 2001/0056391).

Regarding Claims 1, 13, and 25:

Art Unit: 3629

Schultz discloses a method, apparatus, and program for estimating the impact on a user comprising:

obtaining proposed data (Fig. 1 (110));and

calculating an affect, (Fig. 1); and

outputting the affect (page 12, claim 15, displaying the estimate)

Schultz does not disclose that the data is proposed legislation. However, this difference is nonfunctional descriptive data since the data does not alter or reconfigure the system or method steps. The system and the method would perform the same regardless of the type data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F. 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F. 3d 1579, 32 USPQ 2d 1031 (Fed. Cir. 1994)

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made obtain proposed legislative data, calculate and output the affect because such data does not functionally relate to the structure or steps and because the subjective interpretation of data does not patentably distinguish the claimed invention.

Regarding Claims 2, 14, and 26:

Schultz does not disclose method, apparatus, and program wherein the proposed legislation data represents proposed changes to a tax code. However, the type of data is nonfunctional descriptive material and would have been obvious to one of ordinary skill in the art. (See analysis to Claims 1,13, and 25 above)

Art Unit: 3629

5. Claims 3-12, 15-24, and 27-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schultz (US 2001/0056391) in view of Miller (6,202,052).

Regarding Claims 3, 15, and 27:

Schultz discloses the method, apparatus, and program of Claims 1, 13, and 26. However, Schultz does not disclose a method, apparatus, and program wherein calculating an affect includes calculating an estimated change in tax liability by calculating an estimated tax liability. However, Miller discloses calculating tax liability (Figs. 1-4)

It would have been obvious to one of ordinary skill in the art to incorporate into the disclosure of Schultz the teachings of Miller so that tax information could be received, calculated and compared under different tax scenarios.

Regarding Claims 4, 16, and 28:

The Examiner takes Official Notice that it is old and well known to transmit data in an email message.

Regarding Claims 5, 17, and 29:

The fact that the e-mail message indicates the user's support or non-support is non-functional descriptive data that does not affect the method or system.

Regarding Claims 6, 18, and 30:

The Examiner takes Official Notice that it is old and well known to automatically generate electronic mail message when certain data is created.

Regarding Claims 7, 19, and 31:

The fact that the data inserted in the email message is the affect of the proposed legislation is nonfunctional descriptive material. The type data in an email message does not affect the method or system.

Regarding Claims 8, 20, and 32:

The Examiner takes Official Notice that it is old and well known to transmit email messages one or more remote devices automatically.

Regarding Claims 9, 21, and 33:

Miller discloses a method, apparatus, and program wherein calculating an estimated tax liability based on the proposed legislation data includes:

Updating a tax calculation engine based on the proposed tax legislation data (Fig. 2 (27);

Obtaining financial data for the user (Fig. 2 (20)); and

Applying the updated tax calculation engine to the financial data (Fig. 1).

Regarding Claims 10, 22 and 34:

It is old and well known to have is obtained from a server, and wherein the method is implemented in a client to the server.

Regarding Claims 11, 23, and 35:

At is old and well known to download one or more addresses for the one or more remote devices.

Regarding Claims 12, 24, and 36:

The data or message in the e-mail is non-functional descriptive material and is given little patentable weight.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

6,321,205 discloses an automated system for modeling and analyzing business improvement programs.

WO 02/15457 discloses a computer program and method of determining the economic impact of long-term care.

US 2002/0143604 discloses a method for forecasting the effects of trade polices.

Excel 97 discloses "What-" analysis. 2,287,691 discloses a system and method for performing better forecasting of proposed financial changes.

The following articles disclose that looking at how proposed tax changes produce various effects is old and well known.

Kalinka, Susan, Proposed Regulations ...

Logue, Kyle, If taxpayers can't be fooled.....

Valkonen, Tarmo, The Finnish corporate income tax reform....

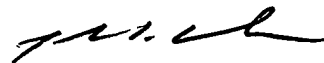
Art Unit: 3629

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan Mooneyham whose telephone number is (703) 305-8554. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JM



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